

REMARKS

Claims 1-14 are pending in the application in their original form. Claims 15-16 are new and supported by the original disclosure, particularly paragraph [0029] being made at this time. Accordingly, no new matter has been added to the application.

Claim Rejection - 35 U.S.C. § 103

The Examiner has rejected claims 1-5 and 9 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,205,075 (Moyer) in view of U.S. Patent No. 767,763 (Reinvaldt). With respect to claim 1, the Examiner has stated that Moyer discloses a termination of a flexible hollow gasket 90 mounted to close a gap between an oven door 150 and an oven face (face of 140) surrounding an oven mouth (mouth of 140) and facing the oven door. The Examiner further states that the gasket 90 is attached to the oven door by fasteners 10 being placed in holes 160 of the oven door. The Examiner states that the gasket includes a tubular member having first and second opposing ends (ends of 90), a resiliently flexible wall 100 formed at least substantially by intertwined fibrous yarns extending between the ends, and a plurality of fasteners 10 extending through the flexible wall and outwardly from the flexible wall and configured to be received in spaced openings in one of the oven door and oven face. The Examiner states that two of the fasteners are located immediately adjacent the first and second ends (joint formed by the ends of the gasket 90 and retained by the clips 10 on an oven door 150) to connect to the oven door or the oven face by the fasteners.

The Examiner states that Moyer discloses the invention substantially as claimed above but fails to disclose that the first end of the flexible wall is at least partially collapsed to form a male end, the second end of the wall is left uncollapsed to form a female end, the male end is adjustably received within the female end to form a joint engaging the first and second ends together to form the closed loop, and the joint being held together by the fasteners immediately adjoining each of the first and second ends of the wall received in the two other spaced openings in the oven door or in the oven face. The Examiner has also stated that the first end of the flexible wall being at least partially collapsed to form a male end and the second end of the wall being left uncollapsed to form a female end are method limitations and are given little patentable weight. The Examiner states that Reinvaldt further discloses a gasket having a first male end F, a

female end G and two fasteners C adjacent the ends that hold a joint formed by the male and female ends (Fig. 4). The Examiner states that it would have been obvious to one having ordinary skill in the art at the time the invention was made to configure the first and second ends of Moyer to be a male end and a female end, respectively, as taught by Reinvaldt, to provide a joint without a lump (page 1, column 2, lines 75-85 of Reinvaldt) or an alternative way of joining a member to form a loop. Applicant respectfully traverses the rejection.

The present invention is directed to a tubular gasket device 10 comprising a tubular member 11 having first and second opposing ends 11a, 11b and a resiliently flexible tubular wall 11c extending between the ends 11a, 11b. Referring to Fig. 1, the device 10 includes an elongated, resilient core 12 with a woven outer jacket 16 surrounding the core 12, the two combining to constitute the tubular member 11, plus a plurality of separate, individual clips 20. The core 12 is a continuous, elongated, seamless, flexible, tubular member with a closed loop, normally circular transverse cross-sectional shape, formed from a plurality of intertwined, knitted, stainless steel or other hardened spring wires 14 in a conventional fashion. The outer jacket 16 is also a continuous, elongated, seamless, flexible tubular member of normally circular cross-sectional shape that closely surrounds and extends along the core 12. The jacket 16 is formed from a multiplicity of intertwined, braided, glass fiber yarns 18 (page 1, lines 13-30).

The male end 10a is formed by radially collapsing the first free end 11a of gasket 10 into an at least particular radially collapsed condition. Referring specifically to Fig. 13, the male end 11a is inserted into the sleeve-like female end 10b to form the joint 80 (page 6, line 4 - page 7, line 9). Referring to Fig. 11, the device 10 is mounted in a conventional fashion to an oven door 150 using clips 20, 20'. The joint 80 is centered between the two clips 20' which adjoin the ends 10a, 10b of the device 10 and which are adjacent to each other with the joint 80 formed between them. Placement of the joint 80 between two clips 20' allows for the ends 10a, 10b to be squeezed together and limits the range of motion of the joint 80 to reduce the risk that the ends will become separated. Each clip 20' is located sufficiently close to the adjoining end 10a, 10b to limit movement of the ends 10a, 10b when joined together and attached to the door 150 (page 7, lines 9-24).

Moyer is directed to an oven gasket 90 and clips 10 used to mount the oven gasket 90 to an oven door 150. The gasket 90 includes an inner tubular support number 110 and an outer braided sealing member 100 made of braided fiberglass (col. 5, lines 14-40). The gasket 90 is a continuous loop and the clips 10 are spaced along the gasket 90 only according to the spacing of holes 160 in the oven door 150 (Fig. 11). Nothing is said about a joint, how such joint is or would be constructed or held together.

Reinvaldt is directed to a metallic gasket for flange couplings that are cast in one piece. The metallic gasket includes tapered entering ends F and enlarged receiving ends G so that one may enter the other and also to avoid a lump and corresponding looseness of the joint (column 2, lines 72-84). The ends F, G are held together by being crushed between flange faces E “so tightly . . . that the yielding metal fills up all the minute irregularities of the harder surfaces E . . . (and which) causes the tin to flow into and fill up whatever space is left between the stem of the bolt and the walls of the holes C” (Reinvaldt page 1, lines 51-64.)

Referring to MPEP 2143, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference “or references when combined” must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991).

Applicant submits that Moyer and Reinvaldt are not properly combinable under 35 U.S.C. § 103. Moyer is directed to a flexible gasket 90 made of braided fiberglass. Reinvaldt, on the contrary, is directed to a solid metallic gasket that is cast in one piece (lines 30-35) and held together by having its ends crushed together. There is no teaching or suggestion in Moyer that metallic gaskets could be used in place of braided fiberglass gaskets. The “casting” and “swagging” construction of Reinvaldt is not suited for use on a resiliently flexible tribular wall like that of Moyer. Any attempt to modify Reinvaldt to have a flexible outer surface or Moyer to

have a cast or swagged partially collapsed end would clearly be hindsight reconstruction of the present invention. Thus, a *prima facie* case of obviousness cannot be met since there is no teaching or suggestion to combine the two references.

Independent claim 1 recites, among other things:

... the first end of the flexible wall being at least partially collapsed to form a male end and the second end of the wall being left uncollapsed to form a female end such that the male end is adjustably received within the female end to form a joint engaging the first and second ends together to form a closed loop, the joint being held together by the fasteners immediately adjoining each of the first and second ends of the wall received in two of the spaced openings.

Even if Moyer and Reinvaldt were combined for argument sake, the combination would still fail to disclose the above-underlined feature of independent claim 1. In the present invention, the joint 80 formed by the joining of the first and second ends 10a, 10b is actually held together by the fasteners 20' securing the gasket to the oven door or face. The fasteners 20' are strategically placed on each side of the joint and received in two of the spaced openings 160. This is so that the joint 80 is held in place. In Moyer, there is no mention of first and second ends of the gasket. Furthermore, there is no mention of specific placement of the clips 10. As seen in Fig. 4, the clips 10 are placed along the gasket 90 only based on the location of the holes 160 of the oven door 150 (col. 7, lines 24-28). Reinvaldt only discloses two ends of a metallic gasket being joined by frictional fit. There is no mention of fasteners immediately adjoining each of the first and second ends of the wall received in two spaced openings. Thus, a *prima facie* case of obviousness cannot be met since there is no teaching or suggestion of the above-underlined novel feature of the present invention even if Moyer and Reinvaldt were combined.

It is also submitted that the first end of the flexible wall being at least partially collapsed to form a male end and the second end of the wall being left uncollapsed to form a female end

are clearly structural features of the present invention and are not method limitations as stated by the Examiner.

Claims 2-5 and 9 are dependent on claim 1 and are patentable for the same reasons set forth above with respect to claim 1. Reconsideration and withdrawal of the rejection of claims 1-5 and 9 are respectfully requested.

The Examiner has also rejected claims 6-8 under 35 U.S.C. 103(a) as being unpatentable over Moyer and Reinvaldt as applied to the claims above, and further in view of U.S. Patent No. 4,986,033 (Weil). Applicant respectfully traverses the rejection. Claims 6-8 are dependent on Claim 1 and are patentable for the same reason set forth above with respect to Claim 1. The Examiner does not rely upon Weil to overcome the infirmity of the proposed combination of Moyer and Reinvaldt and Weil says nothing about any joint. Reconsideration and withdrawal of the rejection of claims 6-8 are respectfully requested.

The Examiner has also rejected claims 1-5 and 10-14 under 35 U.S.C. 103(a) as being unpatentable over Moyer as applied above and further in view of U.S. Patent No. 4,156,533 (Close *et al.*). With respect to claim 1, the Examiner asserts that Moyer discloses the invention substantially as claimed but fails to disclose that the first end of the flexible wall is at least partially collapsed to form a male end and that the second end of the wall is left uncollapsed to form a female end. The Examiner has also admitted that Moyer does not disclose the first end of the flexible wall being at least partially collapsed to form a male end and the second end of the wall being left uncollapsed to form a female end. The Examiner further states that Moyer does not disclose that the male end is adjustably received within the female end to form a joint engaging the first and second ends together to form the closed loop. The Examiner states that Close *et al.* discloses a gasket having a core 40, an outer jacket 42, a male end (end of the core 40 in Fig. 6) and a female end (end of the outer jacket 42) where the male end is inserted into the female end to form a joint. The Examiner further states that an end (end on the left side of Fig. 6) of the core 40 extends beyond an end (and on the left side of Fig. 6) of the outer jacket 42 and an end (and on the right side of Fig. 6) of the outer jacket 42 extends beyond an end (and on the right side of Fig. 6) of the core 40. The Examiner argues that it would have been obvious to one

having ordinary skill in the art the time the invention was made to configure the first and second ends of Moyer to be a male end formed by the core and a female end formed by the outer jacket, respectively, as taught by Close *et al.*, to provide a gasket that is continuous (column 3, lines 56-62 of Close *et al.*) or an alternative way of joining a member to form a loop. Applicant respectfully traverses the rejection.

Close *et al* is directed to a high temperature gasket having a first and second ends. On the first end, core material 40 is moved forward from outer wall 42. On the second end, the outer wall 42 is moved forward from the core material 40 (Fig. 6). The first end is inserted into the second end to form a joint 44 (Fig. 7). An additional piece of sheathing 46 can be included to further strengthen the joining 44 (Fig. 8).

It is initially submitted that the first end of the flexible wall being at least partially collapsed to form a male end and the second end of the wall being left uncollapsed to form a female end are clearly structural features of the present invention and are not method limitations as stated by the Examiner. Even if they were, nothing permits the examiner to ignore any express limitations of the claims. The combination posed by the examiner does not include an at least partially collapsed first end and therefore, fails to teach or suggest all elements of the claims.

Even if Moyer and Close *et al* were combined, the combination would fail to disclose:

... the joint being held together by the fasteners immediately adjoining each of the first and second ends of the wall received in two of the spaced openings.

Nowhere in either Moyer or Close *et al* is a joint being held together by fasteners immediately adjoining each of the first and second ends of the wall received in two space openings disclosed. The clips 10 in Moyer are arranged only according to the arrangement of the holes 160 and the oven door 150 without regard to location of a joining between two ends of the gasket. In Close *et al*, fasteners for holding together a joint that are also received in spaced openings are not disclosed. Instead, Close *et al* only discloses a sleeve 46 for strengthening the

joining 44 by wrapping the sleeve 46 around the joining 44 of the gasket (col. 3, line 67- col. 4, line 1) or applying an adhesive (col. 5, lines 40-42). Thus, claim 1 is patentable because the combination of Moyer and Close *et al* does not show the above-underlined features of claim 1.

Claims 2-5 and 10-14 are dependent on claim 1 and are patentable for the reason set forth above with respect to claim 1. Reconsideration and withdrawal of the rejection of claims 1-5 and 10-14 are respectfully requested. It is submitted that independent claim 1 is allowable, together with all the remaining claims which depend directly or indirectly therefrom.

New claims 15 and 16 respectively call for the first end to be secured and a securement at the first end to maintain the first end in the at least partially collapsed condition. Neither is taught or suggested by any of the references. Examination and allowance of claims 15 and 16 are respectively requested.

CONCLUSION

In view of the above remarks, it is respectfully submitted that the present application including claims 1-16, is in condition for allowance.

Respectfully submitted,



James J. Bono, Jr.

JOHN JAMIESON
Registration No. 29,546
AKIN GUMP STRAUSS HAUER & FELD LLP
One Commerce Square
2005 Market Street, Suite 2200
Philadelphia, PA 19103-7013
Telephone: 215-965-1200
Direct Dial: 215-965-1310
Facsimile: 215-965-1210
E-Mail: jjamieson@akingump.com

JJJ/gem